UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JORG HOFMANN, PRAMOD GUPTA, MANFRED DIETRICH, HANS JURGEN RABE, JURGEN GRONEN and PIETER OOMS

Appeal No. 2004-1995
Application No. 10/018,332

ON BRIEF

Before PAK, OWENS, and WALTZ, Administrative Patent Judges.
PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 11 and 13 through 15 which are all of the claims pending in the above-identified application. We have jurisdiction pursuant to 35 U.S.C. §§ 6 and 134.

APPEALED SUBJECT MATTER

The subject matter on appeal is directed to flexible polyurethane foams produced from polyisocyanates and particular

polyether polyols. Further details of the appealed subject matter are recited in claim 11 reproduced below:

11. A flexible polyurethane foam which is the reaction product of

(1) a polyisocyanate

with

(2) an isocyanate-reactive component comprising a polyether polyol produced by alkoxylation in the presence of a double metal cyanide catalyst having a terminal propylene oxide block, containing at least one ethylene oxide/propylene oxide mixed block and having a number average molecular weight of from 700 to 50,000 g/mole.

PRIOR ART

The examiner relies on the following prior art references:

Hager	5,648,559	Jul. 15, 1997
Kinkelaar et al. (Kinkelaar)	5,668,191	Sep. 16, 1997
Thompson et al. (Thompson)	6,008,263	Dec. 28, 1999
Beisner et al (Beisner)	6,066,683	May 23, 2000

REJECTION

The appealed claims stand rejected as follows:

1) Claims 11 and 13 through 15 under 35 U.S.C. § 102(e) as anticipated by the disclosure of Thompson;

2) Claims 11 and 13 through 15 under 35 U.S.C. § 102(e) as anticipated by the disclosure of Beisner;

3) Claims 11 and 13 through 15 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Hager; and

4) Claims 11 and 13 through 15 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Kinkelaar.

OPINION

We have carefully reviewed the claims, specification and prior art, including all of the arguments advanced by both the examiner and the appellants in support of their respective positions. This review has led us to conclude that the examiner's Section 102 rejections are not well founded. Accordingly, we will not sustain the examiner's Section 102 rejections for the reasons set forth in the Brief and the Reply Brief. We add the following primarily for emphasis.

Under 35 U.S.C. § 102(b) or (e), a prior art reference anticipates the claimed subject matter if it describes every feature of the claimed subject matter, either explicitly or inherently. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 384, 388 (Fed. Cir. 1984). The description of the claimed subject matter in the prior art reference must be clear and unequivocal such that it directs one of ordinary skill in the art to the claimed subject matter without any need for picking and choosing. *In re Schaumann*, 572 F.2d 312, 316-18, 197 USPQ 5, 8-10 (CCPA 1978); *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972).

Here, the examiner has not demonstrated that each of the prior art references relied upon clearly and unequivocally teaches a flexible polyurethane foam produced from reacting a polyisocyanate with a particular polyether polyol having, *inter alia*, a terminal propylene oxide block and at least one ethylene oxide/propylene oxide mixed block, produced by alkoxylation in the presence of a double metal cyanide catalyst. Specifically, as correctly argued by the appellants (Brief, pages 4-8 and Reply Brief, pages 2-3), the examiner has not evinced that the polyether polyols having at least one ethylene oxide/propylene oxide mixed block used in the applied prior art references in producing polyurethane foams also have a terminal propylene oxide block. The appellants correctly explain (Brief, page 5) that:

> As used in Appellants' claims, "terminal propylene oxide block" has it plain meaning, i.e., a terminal block derived from propylene oxide. It does not include ethylene oxide because inclusion of ethylene oxide would result in a mixed block terminal group.

The examiner does not identify the specific teachings in the applied prior art references explicitly or inherently describing the claimed terminal propylene oxide block. See the Answer in its entirety. Thus, we concur with the appellants that the examiner has not established a *prima facie* case of anticipation within the meaning of Section 102. *In re Oetiker*, 977 F.2d 1443, 1445, 24

USPQ2d 1443, 1444 (Fed. Cir. 1992) ("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability."). As such, we are constrained to reverse the examiner's decision rejecting the claims on appeal under 35 U.S.C. § 102 (b) and (e).

REVERSED

CHUNG K. PAK
Administrative Patent Judge)

TERRY J. OWENS
Administrative Patent Judge) BOARD OF PATENT APPEALS AND INTERFERENCES

THOMAS A. WALTZ
Administrative Patent Judge)

CKP/lp

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